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In re Application of VANDERBIST et al.

Application No.: 09/424,247

PCT No.: PCT/BE98/00064

Int. Filing Date: 07 May 1998

Priority Date: 07 May 1997

Attorney Docket No.: 4068-0002-0 PCT

For: DRY POWDER INHALER EXCIPIENT,
PROCESS FOR ITS PREPARATION AND
PHARMACEUTICAL COMPOSITIONS
CONTAINING IT

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:
: DECISION ON REQUEST
: FOR RECONSIDERATION OF
: PETITION TO ACCEPT
: DECLARATION UNDER
: 37 CFR §1.47(a)
:
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This is a decision on applicants' "Request for Reconsideration of Decision to Dismiss Petition Declaration of Philippe Baudier and Request for Extension of Time" requesting the acceptance of the application without the signature of named co-inventor, Paul Maes. The reconsideration was filed 27 September 2000 in the above-captioned application. The request for three month extension of time was accompanied by the appropriate fee and is granted.

BACKGROUND

On 07 May 1998, applicants filed international application No. PCT/BE98/00064 which claimed a priority date of 07 May 1997, and which designated the United States.

No Demand was filed and as a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was to expire 20 months from the priority date, at midnight 07 January 1999.

On 30 November 1999, applicants filed a transmittal letter for entry into the national

stage in the United States which was accompanied by, *inter alia*, basic national filing fee, a petition to revive an unintentionally abandoned application under 37 CFR §1.137(b) and a petition to accept Declaration under 37 CFR §1.47(a).

In a decision mailed 02 May 2000, the petition to revive was granted; however, the petition to accept declaration under 37 CFR §1.47(a) was dismissed on the grounds that applicant had failed to provide factual proof that the non-signing joint inventor, Paul Maes, refused to execute the application or could not be reached after diligent effort.

On 27 September 2000, applicants' filed the instant Request for Reconsideration of Decision to Dismiss Petition Declaration of Philippe Baudier and Request for Extension of Time. The Reconsideration was accompanied by a declaration of Philippe Baudier and exhibits. The Exhibits include (1) an alleged assignment, written in French, from nonsigning inventor Paul Maes to Pharlyse, (2) a copy of an envelope addressed to Paul Maes, at Biovail Corporation International, marked "MOVED REFUSED 1 OCT 1999", (3) an envelope addressed to Paul Maes, at his last known residence as noted on the publication bearing a Belgium postmark of 14 July 2000 and (4) 14 August 2000 facsimile letter from Paul Maes, written in French, to Philippe Baudier.

DISCUSSION

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration **by the person to whom the refusal was made**. Statements by a party not present when an oral refusal is made will not be accepted. [Emphasis added.]

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or

declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted.

Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Furthermore, an application filed pursuant to 37 CFR 1.47 must state the last known address of the nonsigning inventor. (See MPEP 409.03(e).) Mr. Baudier's affidavit indicates that Mr. Maes has provided a new address, at which he can be reached.

Here, Petitioner submitted an affidavit as to Facts under 37 CFR § 1.47(a)(2) executed by Philippe Baudier. Mr. Baudier's declaration indicates that on September 27, 1999, a letter was sent to Mr. Maes, in an effort to obtain Mr. Maes' signature (§4). However, a copy of said letter is not attached (with an English language translation if necessary). Mr. Baudier does not profess first hand knowledge of the letter, that is, there is no indication that Mr. Baudier wrote the letter, knew the contents of the letter or that the correspondence included a complete copy of the application (that is, specification, claims and drawings for this application).

Petitioner has not demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/424,247 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address or identified Mr. Maes' refusal to sign, either in writing or by telephone.

The affidavit also advises that the French language facsimile, dated 14 August 2000, (Ex.4) indicates "that Paul Maes can be contacted at that location [another address for another Biovail facility]" (§7) and "since Paul Maes left SMB/Galephar Company for Biovail, he has attempted to obtain money in exchange for his signature on any further documents required for this application" (§8). This is not evidence that Mr. Maes cannot be found or reached or that he refuses to sign. Mr. Baudier attests that the facsimile reveals Mr. Maes can be contacted at his new place of employment, at a U.S. address in Virginia, however, the evidence of record does not show that any attempt has been made to contact Mr. Maes at this address.

The exhibits, attached to the affidavit, do not illuminate the matter of Mr. Maes' refusal. Exhibit 1 is alleged to be an assignment from Paul Maes to Pharlyse. However, the document is written in French and is not accompanied by an English language translation. It is also noted that no assignment has been recorded in this application.

As for Exhibit 2, the label is addressed to Paul Maes at an address in Ontario, Canada which Mr. Baudier indicates was considered to be Mr. Maes' new employer's address. It is not clear from the petition or the envelope itself that Mr. Maes refused to sign the application. As part of Exhibit 2, a mailing receipt to Paul Maes is provided; however, the receipt carries no receipt number or date-stamp nor is there any explanation as to its significance. The circumstances of Mr. Maes' refusal have not clearly been provided by Exhibit 2, as required under 37 CFR §1.47(a).

Exhibit 3 is a copy of the envelope allegedly sent to Mr. Maes from Mr. Baudier, attached to the petition. The envelope was marked "Return to Sender" and "Moved Refused 1 October 1999". There is no indication that these notations were made by Mr. Maes. It appears that the address label covers a portion of the "Return to Sender" label. No explanation is given for this. In light of the above referenced facsimile which indicates a new address for Mr. Maes. Exhibit 3 does not provide evidence of refusal to sign.

In sum, the evidence submitted does not support a finding that the nonsigning inventor could not be found or reached or that he refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No additional petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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